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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 131026-1/YOD (GERD:0613)						
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Application Number 10/686,290	Filed October 15, 2003							
First Named Inventor George Gao								
Art Unit 2832	Examiner Nguyen, Tuyen T.							

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.
Registration number _____

attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


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November 13, 2006

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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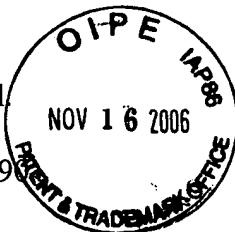
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
George Gao et al.

Serial No.: 10/686,29

Filed: October 15, 2003

For: Insulation System for Oil Filled
Environments



§ Group Art Unit: 2832
§ Examiner: Nguyen, Tuyen T.
§
§ Atty. Docket: 131026-1/YOD/WOL
§ G俞D:0613

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November 13, 2006	Seanelle Dice
Date	Seanelle Dice

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In respect to the Advisory Action of October 12, 2006, Appellants respectfully submit this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal.

The Office Action mailed on July 13, 2006 was based on new grounds for rejection and was made final even though it was the first response subsequent to reopening prosecution following appeal. Because the Appellants believe that the rejections are improper for a number of reasons, the present Appeal has been filed.

The Examiner rejected pending claim 33 under 35 U.S.C. §102(b) and pending claims 1-4, 6-8, and 29-44 under 35 U.S.C. 103(a). Of these, claims 1, 29, 33, 38, and 42 are independent.

Improper Finality of the Office Action

Appellants note that the Examiner reopened prosecution following a panel decision issued on March 29, 2006. Upon reopening, the Examiner entered new grounds for rejections and made the first Office Action containing the new rejections final. *See* Office Action dated July 13, 2006. This finality appears to be *improper* because prior to the Office Action the application was on Appeal. Accordingly, when prosecution is to be reopened, there are very limited circumstances in which the Examiner can make the Office Action final.

In particular, MPEP §1207.04 indicates that an Office Action can be made final upon reopening of prosecution if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an Information Disclosure Statement under 37 C.F.R. § 1.97(c) where no statement under 37 C.F.R. § 1.97(e) was filed. Neither of those conditions has been met in the present case. In particular, no IDS was filed and no amendment was before the Examiner.

Accordingly, Appellants submit that the finality of the Office Action was improper, and at the very minimum, request withdrawal of the finality and prosecution reopened.

Request for Integral Translation of Prior Art Reference

Appellants note that all of the rejections made in the Office Action dated July 13, 2006 were at least partially based upon a Japanese reference (JP 2001-196241, hereinafter “Kurita”). Because references must be considered as a *whole* for what they teach, Appellants are simply unable at the present time to determine whether Kurita does or does not teach the subject matter of the invention, or whether the reference, in fact, teaches away from the combination proposed by the Examiner. Accordingly, Appellants request a fair opportunity and formally request an integral translation of the Kurita reference if they are expected to further respond to the rejections.

Rejections Under 35 U.S.C. § 102

Claim 33 was rejected under 35 U.S.C. § 102 in view of Kurita. Claim 33 recites an insulation system that includes “a plurality of *alternating layers* of polymeric and non-polymeric materials” (emphasis added).

As best understood, Kurita fails to teach *alternating layers* of polymeric and non-polymeric materials. The Examiner appeared to refer to FIG. 1 from Kurita, taken in conjunction with the English translation of the abstract. Appellants submit that one skilled in the art, given only these passages and figure, would conclude that the insulation layer 5 of Kurita includes *one* polypropylene film layer 6 and *one* kraft paper layer 7. The term “alternating layers” in claim 33, on the other hand, implies that more than simply two layers must be included in the recited structure. As properly interpreted in view of the specification of the present application, multiple such layers must be included. In short, it is simply impossible for only two layers to be considered as “alternating.”

Accordingly, Kurita cannot anticipate claim 33 without additional layers of polypropylene film and kraft paper that would be disposed in alternating fashion. Reconsideration and allowance of claim 33 on this basis is requested.

Rejections Under 35 U.S.C. § 103

All of the pending claims 1-4, 6-8 and 29-44 were also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,095,205 to Schroeder et al. (hereinafter “Schroeder”) in view of Kurita. Appellants note that of these, claims 1, 29, 33, 38 and 42 are independent. All these claims are believed to be clearly allowable over the cited reference for the reasons summarized below.

Appellants first note that Schroeder was used by the Examiner as a primary reference. Schroeder was cited for its teaching of multiple layers of insulating material in an insulating unit. The insulating structure taught by Schroeder is, in fact,

best illustrated in FIG. 2 and labeled with reference numeral 30. While Schroeder does teach multiple layers of polyethylene terephthalate film, this film is bounded on either side by aromatic polyamide fiber papers.

Appellants note first that none of the layers of the Schroeder insulating structure is made of a non-polymeric material. That is, both the polyethylene terephthalate films and the polyamide fiber papers are apparently polymeric materials.

Accordingly, it is presumed that the combination proposed by the Examiner would replace at least these paper layers with the kraft paper layer of Kurita. However, even if this were the case, the resulting structure would not read on that recited in each of the independent claims. In particular, all of the independent claims require polymeric and non-polymeric or paper layers. Appellants note that claim 33, as discussed above, recites the subject matter somewhat differently, relying upon “alternating layers” of polymeric and non-polymeric materials. Moreover, in somewhat similar language, the claims, excepting claim 33, further recite that these units are positioned or stacked so as to locate or dispose the non-polymeric or paper material in each unit adjacent to the polymeric material in another insulating unit. That is, the paper or non-polymeric material is alternated with the polymeric material.

The combination proposed by the Examiner would not result in such structures. Rather, it would appear that, although the Examiner is not specific on this point, the paper layers of Schroeder would be replaced by the kraft paper layer of Kurita. Neither reference, however, teaches alternating disposition of these layers. That is, reading Kurita, one skilled in the art would not be prompted to provide multiple units of alternating materials, as noted above with respect to claim 33. Kurita simply teaches a single polypropylene film layer 6 and a single kraft paper

layer 7. Similarly, nothing in either reference would prompt one skilled in the art to replace one or more of the polyethylene terephthalate film layers 42 of Schroeder with a kraft paper layer from Kurita. This replacement is simply not taught by nor is it consistent with the teachings of either reference.

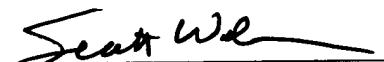
Accordingly, Appellants submit that a *prima facie* case of obviousness has not been made out, insomuch as even in combination, the references would not read on at least independent claims 1, 29, 33, 38 and 42. Moreover, all of the dependent claims are believed to be equally patentable by virtue of their dependency from an allowable base claim and for the subject matter they separately recite.

Reconsideration and allowance of all pending claims are respectfully requested.

For all of the above reasons, Appellants respectfully request that the Panel instruct the Examiner to withdraw the outstanding rejections and allow the pending claims.

Respectfully submitted,

Date: November 13, 2006



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